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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,418	07/27/2006	Jochen Moench	3775	7301

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Striker Striker & Stenby
103 East Neck Road
Huntington, NY 11743

EXAMINER

MACARTHUR, VICTOR L

ART UNIT	PAPER NUMBER
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3679

MAIL DATE	DELIVERY MODE
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09/17/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/587,418

Applicant(s)

MOENCH ET AL.

Examiner

Victor MacArthur

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7/27/2006</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Specification

The disclosure is objected to as failing to comply with 37 CFR 1.77(c) for not including proper section headings.

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

Preamble-Intended Use

The preamble of claim 1 recites functional intended use limitations that are not taken in combination with the positively recited structure as follows:

In lines 1-3 of the preamble of claim 1, it appears that the applicant does not intend to positively claim “for mechanically connecting a motor housing (2) of a motor (5) to a transmission housing (3) of a transmission (7), in which the motor (5) acts on the transmission (7) via a motor shaft (6)”. For purposes of examination the examiner has considered the claims without combination. “(T)he recitation of a new intended use for an old product does not make a claim to that old product patentable”, *In re Schreiber*, 44 USPQ2d1429 (Fed. Cir. 1997).

Accordingly, the prior art meets the applicant’s claimed intended use merely by being capable of such intended usage regardless of whether or not such capability is expressly disclosed (i.e., wherein capability is inherent to the disclosed structure). If the applicant wishes to positively recite the above intended use phraseology then the limitation “for” should be deleted from line 1 of the claim. Otherwise, it is well established that patentability of a device is based on the structural recitations thereof and not how such structure is intended to be used. The claims are drawn solely to “A connecting device” and it is that “connecting device” structure for which patentability is to be determined.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. Take for instance the following examples:

- It is unclear if the phrase “wherein at least one connection element is provided” (line 4 of claim 1) is meant to set forth positive structure comprised within the “connecting device” (line 1 of claim 1) or if the phrase is merely a recitation of intended use for the “connecting device”. Note that currently almost the entirety of claim 1 could be taken to be a mere intended use preamble since no specific statement is made that the connecting device “comprises” or “consists” of anything. For purposes of rejection in view of the prior art the examiner takes the phrase to mean --wherein the connecting device comprises at least one connection element--.
- It is unclear how the recitation “the connecting element is embodied” (line 6 of claim 1) is meant to limit the claim. Does the limitation mean to say that the connecting element is included (in accordance with Merriam-Webster’s Collegiate Dictionary, tenth edition) within some element or group of elements? If so what elements? Does the limitation mean to say that the connecting element is configured in some manner.

If so, the examiner suggests using the more appropriate terminology (i.e.,--configured for--). The term “embodied” is used repeatedly throughout the claims in a similar unclear manner.

- It is unclear what the limitation “at least essentially rigid” (claim 2) is meant to convey. The term “at least” is commonly used to set forth a minimum requirement whereas the term “essentially” generally refers to a degree of importance or necessity (in accordance with Merriam-Webster’s Collegiate Dictionary, tenth edition). Does the applicant mean to say that the rigidity is at a minimum required. If so what would a maximum condition require? Non-rigidity?
- It is unclear what the limitation “at least essentially elastically deformable” (line s 2-3 of claim 3) is meant to convey. The term “at least” is commonly used to set forth a minimum requirement whereas the term “essentially” generally refers to a degree of importance or necessity (in accordance with Merriam-Webster’s Collegiate Dictionary, tenth edition). Does the applicant mean to say that the elastic deformability is at a minimum required. If so what would a maximum condition require? Non-deformability? Plastic deformability?
- It is unclear what element the pronoun “it” (line 5 of claim 4) refers to. Does “it” refer to the connecting device, connecting element, motor housing or transmission housing?
- It is unclear what element the pronoun “its” (line 3 of claim 13) refers to. Does “its” refer to the connecting device or the connecting element.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-10 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Zagorski (U.S. Patent 3,401,282).

Claim 1. Zagorski discloses (figs.1-6) a connecting device, wherein at least one connecting element (14) is provided.

- The prior art connecting device is fully capable of performing the intended use of being for mechanically connecting a motor housing (2) of a motor (5) to a transmission housing (3) of a transmission (7), in which the motor (5) acts on the transmission (7) via a motor shaft (6)
- The prior art connecting element is fully capable of connecting a motor housing indirectly to a transmission housing, in that it's shape allows it to do so.
- The prior art connecting element is fully capable of being at least partially deformed in an elastic fashion (in that it is metal) such that it is embodied (by its material) so that when a motor housing moves relative to a transmission housing in a rotating fashion around an axis predetermined by the motor shaft, the connecting element is able to be at least partially deformed in an elastic fashion.

Claim 2. Zagorski discloses the connecting device as recited in claim 1. Furthermore:

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- The prior art connecting element is fully capable of being embodied as at least essentially rigid (in that it is metal) in a direction (Z) radial to an axis of a motor shaft.

Claim 3. Zagorski discloses the connecting device as recited in claim 1, wherein the connecting element is elastically deformable (in that it is metal).

- The prior art connecting element is fully capable of performing the intended use of being embodied such that it is orientated with respect to a motor shaft and at least essentially elastically deformable in a direction axial to an axis of a motor shaft.

Claim 4. Zagorski discloses the connecting device as recited in claim 1. Furthermore:

- The prior art connecting element is fully capable of performing the intended use of being embodied so that it is possible to connect a motor housing to a transmission housing, spaced axially apart from it.

Claim 5. Zagorski discloses the connecting device as recited in claim 1, wherein the connecting element is embodied as U-shaped.

Claim 6. Zagorski discloses the connecting device as recited in claim 5, wherein the connecting element has a first leg (left leg of 14) and second leg (right leg of 14) that are connected to each other by a bridge piece (top bridge portion of 14).

Claim 7. Zagorski discloses the connecting device as recited in claim 6, wherein it is **possible** (though not necessary) to connect the connecting element to a motor housing in a region of an end surface of the first leg.

Claim 8. Zagorski discloses the connecting device as recited in claim 6, wherein it is **possible** (though not necessary) to connect the connecting element to a transmission housing in a region of an end surface of the second leg.

Claim 9. Zagorski discloses the connecting device as recited in claim 6, wherein the connecting element has a recess (recess in 14 receiving 38) and in the region of the recess, the connecting element is embodied as at least essentially concave.

Claim 10. Zagorski discloses the connecting device as recited in claim 9, wherein the recess is **partially** (but not necessarily completely) embodied in an **approximately** (but not necessarily exactly) ellipsoidal form (in that the recess is a non-circular curve similar to a portion of an ellipse).

Claim 13. The connecting device as recited in claim 1, wherein relative to its axial dimension (X) and its radial dimension (Z), the connecting element (15, 26) is embodied as thin in a predetermined circumference direction (Y) in relation to the rotation direction of the motor shaft (6).

Claims 1, 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Henderson (U.S. Patent 5,237,871).

Claim 1. Henderson discloses (figs. 1-17) a connecting device, wherein at least one connecting element (visco elastic coated springs of col.2, ll.25-35; and plastic rings of col.7, ll.60-63) is provided.

- The prior art connecting device is fully capable of performing the intended use of being for mechanically connecting a motor housing of a motor to a transmission

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housing of a transmission, in which the motor acts on the transmission via a motor shaft.

- The prior art connecting element is fully capable of connecting a motor housing indirectly to a transmission housing, in that it's shape allows it to do so.
- The prior art connecting element is fully capable of being at least partially deformed in an elastic fashion such that it is embodied so that when a motor housing moves relative to a transmission housing in a rotating fashion around an axis predetermined by the motor shaft, the connecting element is able to be at least partially deformed in an elastic fashion.

Claim 11. Zagorski discloses the connecting device as recited in claim 1, wherein the connecting element is at least partially comprised of an elastic plastic (plastic rings of col.7, ll.60-63). Note that all plastics inherently have some degree of elasticity.

Claim 12. Zagorski discloses the connecting device as recited in claim 1, wherein the connecting element is at least partially coated with a viscoelastic material (visco elastic coated springs of col.2, ll.25-35).

Conclusion

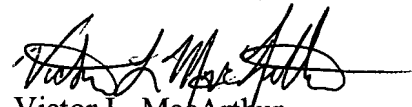
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor MacArthur whose telephone number is (571) 272-7085. The examiner can normally be reached on 8:30am - 5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

September 13, 2007


Victor L. MacArthur
Patent Examiner
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